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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,413	12/22/2000	Hidenori Takata	35.C15009	8023

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EXAMINER

BONZO, BRYCE P

ART UNIT	PAPER NUMBER
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2184

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/742,413

Applicant(s)

TAKATA, HIDENORI

Examiner

Bryce P Bonzo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

NON-FINAL OFFICIAL ACTION

Status of the Claims

Claims 1-9 are rejected under 35 USC §102.

Claim 10 is rejected under 35 USC §103.

Claims 1-6 are rejected under Obvious-type Double Patenting.

Rejections under Obvious-type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are rejected as being an obvious variation over Unites States Patent

Application 09/853,684, a commonly owned Application.

Claims 1-6 recite:

1. A storage medium for storing software and management software for managing said software, wherein said management software comprises a step of restoring a management state of said software.

2. The storage medium according to claim 1, wherein said storage medium comprises a step of storing a predetermined address for connection so that the restoration can be performed.

3. An information processing apparatus having storage means for storing management software for managing software, comprising means for restoring a management state of said software; and

means for connecting to a predetermined site through a network to restore the management state of said management software by said restoring means.

4. The information processing apparatus according to claim 3, further comprising means for receiving information from a predetermined site and storing the information.

5. An information processing apparatus, comprising:

means for restoring a management state of management software for managing software; and control means for displaying a predetermined site for connecting to the predetermined site through a network to restore the management state of said management software by said restoring means.

6. The information processing apparatus according to claim 5, further comprising

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selection means for restoring the management state by said means for restoring the management state.

Unites States Patent Application 09/853,684 recites:

1. A storage medium for storing software and management software for managing said software, wherein said management software comprises a step of restoring and changing a management state of said software.
2. The storage medium according to claim 1, wherein said storage medium comprises a step of storing a predetermined address for connection so that the restoration can be performed.
3. An information processing apparatus having storage means for storing management software for managing software, comprising means for restoring and changing a management state of said software; and means for connecting to a predetermined site through a network to restore the management state of said management software by said restoring and changing means.
4. The information processing apparatus according to claim 3, further comprising means for receiving information from a predetermined site and storing the information.

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5. An information processing apparatus, comprising:

means for restoring and changing a management state of management software for managing software; and control means for displaying a predetermined site for connecting to the predetermined site through a network to restore the management state of said management software by said restoring and changing means.

6. The information processing apparatus according to claim 5, further comprising selection means for restoring and changing the management state by said means for restoring and changing the management state.

It is well settled that the omission of an element and its function (in this instance the changing means) is an obvious expedient if the remaining elements perform the same function as before (In re Karlson, 136 USPQ 184 CCPA 1963). As such it would have been obvious to one of ordinary skill in the art at the time of invention to remove the change means to the expedite development of the invention. As such these claims are *provisionally* rejected under Obvious-type Double Patenting, pending allowance of either application or significant amendment to either application.

Rejections under 35 USC §102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Shannon (United States patent No. 5,852,713).

As per claim 1, Shannon discloses:

A storage medium for storing software and management software for managing said software (column 1, lines 10-19), wherein

said management software comprises a step of restoring a management state of said software (column 2, lines 56-59).

As per claim 2, Shannon discloses:

The storage medium according to claim 1, wherein

said storage medium comprises a step of storing a predetermined address for connection so that the restoration can be performed (column 3, lines 16-22).

As per claim 3, Shannon discloses:

An information processing apparatus having storage means for storing management software for managing software, comprising

means for restoring a management state of said software (column 2, lines 56-59); and

means for connecting to a predetermined site through a network to restore the management state of said management software by said restoring means (figure 2).

As per claim 4, Shannon discloses:

The information processing apparatus according to claim 3, further comprising means for receiving information from a predetermined site and storing the information (column 1, lines 10-19).

As per claim 5, Shannon discloses:

An information processing apparatus, comprising:

means for restoring a management state of management software for managing software (column 1, lines 10-15); and

control means for displaying a predetermined site for connecting to the predetermined site through a network to restore the management state of said management software by said restoring means (column 3, lines 8-19; column 4, lines 9-20).

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As per claim 6, Shannon discloses:

The information processing apparatus according to claim 5, further comprising selection means for restoring the management state by said means for restoring the management state (column 4, lines 18-20).

As per claim 7, Shannon discloses:

A host apparatus for communicating with an information processing apparatus having means for restoring a management state of management software for managing software (column 3, lines 40-55), and means for connecting to a predetermined site to restore the management state of the management software by said restoring means (column 3, lines 10-18; column 4, lines 9-32), and restoring the management state of said management software, comprising (column 6, lines 18-23)

means for transmitting information for use in restoring the management state of said management software in response to a request from said information processing apparatus(column 5, lines 62-67).

As per claim 8, Shannon discloses:

The host apparatus according to claim 7, further comprising means for storing information for use in restoring a management state for plural pieces of management software (column 6, lines 11-17; column 3, lines 19-25).

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As per claim 9, Shannon discloses:

The host apparatus according to claim 7, further comprising means for storing different pieces of information for each piece of software to restore the management state for plural pieces of application software (column 3, lines 41-50; column 4, lines 30-37).

Rejections under 35 USC §103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shannon.

As per claim 10, Shannon discloses:

The host apparatus according to claim 9, further comprising means for *presenting* contents of means for storing information for restoring the management state for plural pieces of application software (column 4, lines 9-23; column 3, lines 10-18).

Shannon does not explicitly disclose *displaying* the contents. The Examiner asserts that in the vast majority of computer systems, user interfaces are provided via a display, whether it be lights or monitors. Shannon is disclosed as running on a on an

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MS-DOS system. MS-DOS is notoriously well known to have been designed and operated with displays in mind. Displays provide the user with visual representation of data allowing easy assimilation of computer output. Thus it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the well known use of displays into the MS-DOS system of Shannon to allow easy review of data as presented by the operating system, providing a more useful user experience.

Examiner's Comment

Applicant is advised that after careful review of the specification and the claims, the use of the "software batteries" is a prevalent topic. Upon review of the claims, this area of is untouched, and as a result the claims are particularly broad. Applicant is advised to incorporate language directly related to the "software battery" concept in order to expedite this application's resolution to possible allowance.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryce P Bonzo whose telephone number is (703)305-4834. The examiner can normally be reached on Monday through Friday from 5:30AM to 2:00PM.

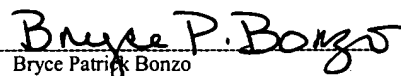
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel, can be reached on (703) 305-9713. For facsimile transmission:

After-final (703) 746-7238

Official (703) 746-7239

Non-Official/Draft (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Bryce Patrick Bonzo
Patent Examiner